

Docket No.: 050069-0111



PATENT

APR
IPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 20277
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Toshihiro SADAOKA, et al.	:	Confirmation Number: 4541
	:	
Application No.: 10/089,245	:	Group Art Unit: 1616
	:	
Filed: August 21, 2002	:	Examiner: Choi, Frank I.
	:	
For: SEBUM ABSORBING PAPER COMBINING HYDROXYAPATITE		

PETITION FOR SUPERVISORY REVIEW
UNDER 37 C.F.R. § 1.181

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a petition for supervisory review under 37 C.F.R. § 1.181 from the Examiner's decision set forth in the Final Rejection dated November 17, 2005, wherein the Examiner required Petitioners to provide a satisfactory showing by way of an affidavit under 37 C.F.R. § 1.132 that the inventorship of the application is correct. An appeal brief is being concurrently filed in this application appealing the final rejection of claims 1-3.

FACTS

1. In a Final Office Action mailed June 15, 2004, claims 1-3 were rejected under 35 U.S.C. § 102(f) because Petitioners allegedly did not invent the claimed subject matter as evidenced by JP 2002-330820 (JP '820), and claim 1 was provisionally rejected under 35 U.S.C. § 102(f) as evidenced by JP 2003-038248 (JP '248).

2. Petitioners traversed the rejection and provisional rejection under 35 U.S.C. § 102(f) in a Request for Reconsideration under 37 C.F.R. § 1.116 filed September 15, 2004.

3. Petitioners appealed the rejection and provisional rejection under 35 U.S.C. § 102(f) to the Board of Patent Appeals and Interferences in an Appeal Brief filed December 15, 2004.

4. On March 20, 2005, the Examiner reopened prosecution of the instant patent application and withdrew the rejection of claims 1-3 under 35 U.S.C. § 102(f) as evidenced by JP '820, and the provisional rejection of claim 1 under 35 U.S.C. § 102(f) as evidenced by JP '248 because there was no evidence that the inventors of JP '820 and JP '248 communicated the subject matter of the claimed invention to the present inventive entity prior to filing the present application. However, the Examiner required the Petitioners to provide a satisfactory showing by way of affidavits under 37 C.F.R. § 1.132 that the inventorship of the application is correct.

5. In a Request for Reconsideration filed August 23, 2005, Petitioners traversed the Examiner's requirement of affidavits under 37 C.F.R. § 1.132.

6. In a Final Rejection mailed November 17, 2005, the Examiner again required the Petitioners provide a satisfactory showing by way of affidavits under 37 C.F.R. § 1.132 that the inventorship of the application is correct.

7. In a Request for Reconsideration filed February 17, 2006, Petitioners again traversed the Examiner's requirement of affidavits under 37 C.F.R. § 1.132.

8. In an Advisory Action mailed March 1, 2006, the Examiner maintained the requirement for a declaration under 37 C.F.R. § 1.132.

'APPLICANTS' POSITION

Although the Examiner withdrew the rejection of claims 1-3 under 35 U.S.C. § 102(f) based upon JP '820 and the provisional rejection of claim 1 under 35 U.S.C. § 102(f) based upon JP '248, the Examiner requires that a Rule 132 affidavit be filed that provides factual evidence that the named applicants of the present application are the inventors of the claimed invention. The Examiner bases this requirement on *In re Katz*, 687 F.2d 450, 215 USPQ 14, 18 (C.C.P.A. 1982). The Examiner's requirement of declaration under 37 C.F.R. § 1.132 is traversed, and reconsideration and withdrawal thereof respectfully requested.

Applicants respectfully submit that the Examiner has misinterpreted the holding in *In re Katz*. The Examiner has no basis for requiring a Rule 132 affidavit since there is no ambiguity regarding inventorship and the Examiner has withdrawn the rejections under 35 U.S.C. § 102(f). *In re Katz* involved claims that were rejected under 35 U.S.C. § 102(a) and (g). *Katz* does not hold that an affidavit can be required when the claims are not subject to a rejection under section 102. There is no teaching in *Katz* that an examiner can require an affidavit in view of references that are not cited in prior art rejections.

The Examiner also cites MPEP § 2137 as supporting his position. However, MPEP § 2137 clearly states "it is incumbent upon the inventors named in an application, in reply to an inquiry regarding the appropriate inventorship under **subsection (f)**, or to **rebut a rejection** under 35 U.S.C. § 102(a) or (e), to provide a satisfactory showing by way of affidavit under 37 C.F.R. § 1.132" There is no rejections or inquiries under any subsections of 35 U.S.C. § 102 in this application, as the Examiner has withdrawn the rejections under 35 U.S.C. 102(f), thus there should be no requirement for the inventors to submit an affidavit under 37 C.F.R. § 1.132.

Further, the Examiner already has a declaration asserting the inventors of the present application are in fact the correct inventors; the Declaration that was filed with the Response to the Notice of Missing Parts on August 21, 2002. The Examiner has no basis upon which to challenge the Declaration filed on August 21, 2002. As recognized by the Examiner, the relied upon disclosures in JP '820 and JP '248 are just that – disclosures not claims. The inventors of JP '820 and JP '248 do not lay claim to the portions of the disclosure previously relied upon by the Examiner. Since there are no pending rejections, the Declaration filed August 21, 2002 must be accepted.

REQUEST FOR RELIEF

Based upon the foregoing, Petitioners respectfully solicit the Honorable Commissioner to exercise supervisory authority under 37 C.F.R. § 1.181 and direct the Examiner to withdraw the requirement for an affidavit under 37 C.F.R. § 1.132.

Since this petition is pursuant to 37 C.F.R. §1.181, no petition fee is required. To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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